

REMARKS

After entry of this amendment, claims 20-49 are pending in the application. Claims 20, and 36-41 are amended to provide proper antecedent basis and to more particularly point out and distinctly claim the subject matter of the invention being claimed by the applicant. Reconsideration of the application as amended is requested.

In the Office Action dated July 15, 2003, the Examiner rejected claims 20-31, 33, and 36-49 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The recitation of "a moveable member" in claim 20, line 3, has been amended to indicate that it is the moveable member previously set forth in the preamble of the claim. The recitation in Claim 1, line 10 of "including a sensor" has been deleted. The recitation relating to "control means" in Claim 36, lines 12 through 13 have been deleted, and the dependent claims have been amended accordingly. It is submitted that these amendments traverse and overcome the rejections noted by the Examiner under 35 U.S.C. § 112, second paragraph. The Examiner inquires what structure corresponds to the control means. It is submitted that the control means can include the control program. Reconsideration of Claims 20-31, 33, 36-49 is requested.

Claims 20-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buchanan '071. The Examiner states that the Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120, because the invention as set forth in the instant application is not disclosed in the manner provided by the first paragraph of § 112 of this title in the previously filed U.S. patent application, now U.S. Patent No. 5,906,071. In particular, the Examiner notes that the parent application, now U.S. Patent No. 5,906,071, fails to set forth any method steps. As stated by the Federal Circuit:

A C-I-P application is different from an original patent application . . . in that it often generates two effective filing dates applicable to different parts of the same patent. New matter in a C-I-P application has the filing date of that C-I-P application. The earlier filing date of the parent application pertains to material in the C-I-P application as disclosed in the prior application. . . . If matter added through amendment to a C-I-P application is deemed inherent in whatever the original parent application discloses, however, that matter also is entitled to the filing date of the original, parent application.

See *Litton Cys., Inc., v. Whirl Pool Corp.*, 728 F. 2d 1423, 1438, 221 USPQ 97, 106 (Fed. Circuit 1984). (Emphasis added).

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. The Examiner also rejects claims 20-49 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. It is submitted that the specification of the original application incorporates an adequate written description of the function inherently disclosed in the drawings as originally filed. In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicated by resort to known scientific laws. *See In re Fisher*, 427 F.2d 833, 166 USPQ 18 (C.C.P.A. 1970). The C.C.P.A. has described the general test for determining whether a drawing can constitute an adequate written description of the invention under §112, first paragraph as follows:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason *that* what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* "form the basis of a valid claim." *See in re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (C.C.P.A 1962) (emphases in original). The C.C.P.A. has also stated the following general rule for determining when subject matter is inherently disclosed in the specification:

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

See in re Smythe, 480 F.2d 1376, 178 USPQ 279, 285 (C.C.P.A. 1973). In the present application, the original drawing Figures of the parent application illustrate the functional method now claimed, as is evidenced by the Examiner's own rejection. Therefore, the specification of the parent application includes an adequate written description of the invention consistent with that disclosed in the original drawing Figures to be entitled to the earlier filing date. From the Examiner's own formulation of the rejection under 103, the subject matter added in the C-I-P application is inherent in the original parent application, since the Examiner states that "the use of the apparatus, as disclosed by Buchanan '071 would lead to the method steps set forth in Claims 20-49. Therefore, the method steps set forth in Claims 20-49 are inherently disclosed in the Buchanan '071 reference and are entitled to the earlier filing date of

the parent application and can not be used as a reference in rejecting these claims. The Examiner further asserts that even if Buchanan '071 had disclosed these specific method steps and the instant application had priority under 35 U.S.C. § 120 to Buchanan '071, Buchanan '071 would still be prior art under both 35 U.S.C. § 102 and 103 because the instant application is by another.

STATEMENT OF COMMON OWNERSHIP

Pursuant to MPEP § 706.02(l)(2) and 35 U.S.C. § 103 (c), the following statement is made concerning common ownership of U.S. Patent No. 5,906,071 issued on March 25, 1999 corresponding to Application Serial No. 08/908,126 filed in the inventor name of Harry C. Buchanan, Jr., and Application Serial No. 09/832,678 filed on April 11, 2001 in the names of Marian E. Clark, Harry Charles Buchanan, Jr., and James A. Jackson, Jr., which is a continuation of U.S. Application Serial No. 09/426,651 filed October 25, 1999, now U.S. Patent No. 6,430,875, which is a divisional application of Application Serial No. 09/164,681 filed on October 1, 1998, now U.S. Patent No. 5,979,114, which is a Continuation-In-Part of Application Serial No. 08/908,126, filed August 11, 1997, now U.S. Patent No. 5,906,071, which is a continuation of Application Serial No. 08/575,643 filed December 20, 1995, now abandoned, and which is a Continuation-In-Part of Application Serial No. 08/501,557 filed July 12, 1995, now U.S. Patent No. 5,582,279 were, at the time that the invention of the present application was made, commonly owned by Valeo Electrical Systems, Inc. through assignment by the inventors and/or an obligation to assign by the inventors, and/or by purchase of the prior patents from ITT Automotive Electrical Systems, Inc. Accordingly, the reference is not properly considered to be prior art under 35 U.S.C. § 102 or 103 with respect to the present invention. Reconsideration of the Examiner's rejection is requested.

It is respectfully submitted that this Amendment traverses and overcomes all of the Examiner's objections and rejections to the application as originally filed. It is further submitted that this Amendment has antecedent basis in the application as originally filed, including the specification, claims and drawings, and that this Amendment does not add any new subject matter to the application. Reconsideration of the application as amended is requested. It is respectfully submitted that this Amendment places the application in suitable condition for allowance; notice of which is requested.

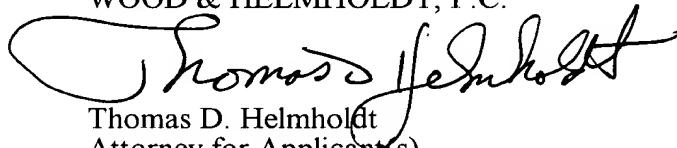
**Application Serial No. 09/832,678
Date November 17, 2003
Reply to Office Action dated July 15, 2003**

Page 14 of 14

If the Examiner feels that prosecution of the present application can be expedited by way of an Examiner's amendment, the Examiner is invited to contact the Applicant's attorney at the telephone number listed below.

Respectfully submitted,

YOUNG, BASILE, HANLON, MacFARLANE,
WOOD & HELMHOLDT, P.C.



Thomas D. Helmholdt
Attorney for Applicant(s)
Registration No. 33181
(248) 649-3333

3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107

Dated: November 17, 2003
TDH/sem